



New claims 85-88, directed to an isolated antibody raised against a mammalian Presenilin protein or an antigenic fragment thereof, are supported by the specification at, *e.g.*, page 63, line 1 to page 65, line 4; and by Example 10, pages 91-92.

No new matter has been added by way of this amendment. Each of the Examiner's objections and rejections are discussed below.

### **Claim Objections**

The Examiner has objected to claims 74-79 for allegedly reciting an improper Markush group.

After entry of the present amendment, claims 74, 75, 77-81, and 84-88 read on antibodies that bind to or that are raised against SEQ ID NOS: 2, 4, or 134, while claims 76 and 82-83 recite antibodies that bind to peptides of SEQ ID NOS: 2 and 134. As described in the paragraph on page 6, lines 12-23 of the substitute specification filed on May 15, 2002 (including the May 8, 2003 amendment to said paragraph), SEQ ID NOS:2 and 134 are human sequences derived from different clones, and SEQ ID NO:4 is the corresponding mouse sequence.<sup>2</sup> Further, as shown in the ClustalW alignment of these sequences in the document attached as Exhibit 1, SEQ ID NOS: 2 and 134 differ in one amino acid residue only, and SEQ ID NOS: 2 and 4 are 89% identical.

It is respectfully submitted that antibodies that bind to or that are raised against SEQ ID NOS:2, 4, and 134 (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility (see citation of *In re Harnish* in paragraph 7 of the office action). Specifically, antibodies to the human and mouse orthologues of applicant's novel protein share common utilities in any number of applications, *i.e.*, in detecting expression of presenilin protein in tissues, ELISA assays, and affinity chromatography of presenilin samples.

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<sup>2</sup> It is noted that SEQ ID NO:4 and SEQ ID NO:136 are, in fact, identical.



recognizes”, “selectively binds”, “selectively recognizes”), the scope of the claims has remained the same.

It is therefore believed that the present rejection has been overcome and should be withdrawn.

### **Request for Rejoinder**

Since it is believed that, upon entry of the present amendment, claim 74 is allowable, rejoinder of claims 80 and 81 is respectfully requested. See *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 37 USPQ2d 1663 (Fed. Cir. 1996). See also MPEP 821.04, which states (emphasis added),

Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. See MPEP Section 806.05(f) and Section 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 C.F.R. 1.142. See MPEP Section 809.02(c) and Section 821 through Section 821.03. However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

See, also, USPTO Official Gazette article entitled “Guidance on the treatment of product and process claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. 103(b)”, 1184 O.G. 86 (March 26, 1996), the text of which is attached as Exhibit 2.

**Conclusion**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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Respectfully submitted,

By 

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Limited Recognition Under  
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Exhibit 1: ClustalW alignment of SEQ ID NOS:2, 4, and 134  
Exhibit 2: 1184 O.G. 86 (March 26, 1996)